REMARKS

Claims 1 and 46 are currently amended. Claim 11 is currently

canceled. Claims 1-10, 12-20 and 45-51 remain in the application for

consideration. In view of the following remarks, Applicant respectfully

requests reconsideration and allowance of the subject application.

§ 103 Rejections

Claims 1-11, 13 and 45 stand rejected under 35 U.S.C. §103(a) as

being obvious over U.S. Patent No. 6,309,301 to Sano (hereinafter "Sano")

in view of U.S. Provisional Patent Application No. 60/201,163 to Shih et

al. (hereinafter "Shih").

Claims 14-15 and 17-20 stand rejected under 35 U.S.C. §103(a) as

being obvious over Sano in view of Shih and further in view of U.S. Patent

No. 6,928,433 to Goodman et al. (hereinafter "Goodman").

Claims 46-51 stand rejected under 35 U.S.C. §103(a) as being

obvious over Goodman.

The Claims

Claim 1 has been amended, and as amended recites a game console

comprising (added language appears in bold italics):

- a memory;
- a processor coupled to the memory; and

- a console application stored in the memory and executable
  on the processor, the console application configured to allow

  selection of a plurality of stored audio tracks by a user of the
  game console, wherein the game console is further

  configured to create *one or more soundtracks* containing the

selected audio tracks and associate each of the one or more soundtracks with one or more *particular games such that a particular soundtrack is played when the particular game is launched.*

In making out a rejection of this claim, the Office argues that the combination of Sano and Shih renders claim 1 obvious. Claim 1 has been amended with the language of canceled dependent claim 11. The Office, in its last Office Action, failed to make out a proper rejection of dependent claim 11. Nonetheless, and in light of this amendment, claim 1 is allowable.

First, the Office has failed to make out a prima facie case of obviousness because Sano's disclosure has no need for Shih's teachings as argued by the Office. The Office argues that one with skill in the art would be motivated to modify Sano with Shih because it would be desirable to allow a user to incorporate the user preference songs into the game. However, Sano does not teach or suggest in any way that it would be desirable to allow the user to incorporate the user preference songs into the game. Sano specifically teaches:

> A game communication system enhancing and improving clarity of players perception of a game. The game communication system includes gaming machine units connected to each other through communication modules which are adapted to perform a communication procedure within the game communication system. Each of the *gaming machine units* includes communication units adapted to execute the communication procedure to ensure bi-directional communications among the gaming machine units, a performance unit performing a sound track for a corresponding gaming machine unit, and a synchronization data setting unit setting a synchronization data which is used to control operation timing of the performance unit. (Sano Abstract).

Accordingly, Sano is concerned with communication among gaming machine units, such as arcade video game units that one might play at a video arcade. Sano does not ever mention the ability or desire to allow a user to customize the game, let alone customize a game with the user's choice of music. Accordingly, the motivation given by the Office as to why one would modify Sano with Shih, is improper. For at least this reason, this claim is allowable.

In addition, Sano and Shih do not teach or suggest, either singly or in combination with one another, that the game console is further configured to create *one or more soundtracks* containing the selected audio tracks and *associate each of the one or more soundtracks with one or more particular games such that a particular soundtrack is played when the particular game is launched.*

In making out the rejection of claim 11, the subject matter of which is now incorporated into claim 1, the Office argued that "Sano discloses associating the soundtrack with the game (citing to Sano, Col. 13, lines 29-31). For the convenience of the Office, the section of Sano which the Office claims teaches this subject matter, is reproduced below:

Sano, Column 13, Lines 24-31
Performance data train 82 is stored in performance data memory 80 in the form of, for example, note data obtained from musical notes and data for controlling the PCM sound source (FIG. 8). Performance data train 82 is separated for each sound track such as "advantaged", "diamond", "dead" and "just before the game is over". *Accordingly, the sound tracks can be selected and read out depending on the event during the game.*

As should be apparent from the excerpt above, Sano teaches associating **sound tracks** with **specific events** that occur **during a game**. For instance, a specific sound track may be played when a player dies. However, Sano does not teach or in any way suggest that the game console is further configured to create **one or more soundtracks** containing the selected audio tracks and **associate each of the one or more soundtracks with one or more particular games such that a particular soundtrack is played when the particular game is launched**. To this extent, Shih adds nothing of significance.

As such, the Office has failed to make out a *prima facie* case of obviousness because the combination of Sano and Shih fails to teach all of the elements of claim 1. For at least this reason, this claim is allowable.

Claims 2-10, 13 and 45 depend from claim 1 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 1, are neither shown nor suggested by the reference of record either singly or in combination with one another.

Claim 14 recites a game console comprising:

- a memory; and
- a processor coupled to the memory, the processor being configured to present a first user interface to facilitate selection of stored audio tracks used to create a soundtrack containing the selected audio tracks, the processor further configured to present a second user interface to facilitate playback of created soundtracks stored in the memory.

In making out the rejection of claim 14, the Office argues that the combination of Sano, Shih and Goodman renders this claim obvious. The Office refers Applicant to claim 1, which gives a reason as to why Sano and Shih are combinable. The Office then admits that the combination of Sano and Shih fails to teach *the processor being configured* to present a first user interface to facilitate selection of stored audio tracks used to create a soundtrack containing the selected audio tracks, the processor further configured to present a second user interface to facilitate playback of created soundtracks stored in the memory. Applicant agrees. The Office argues however, that Goodman teaches this subject matter and that it would have been obvious to combine Goodman with Sano and Shih in order to allow the player to playback a specific favorite soundtrack. Applicant disagrees and submits that the Office has failed to make out a *prima facie* case of obviousness.

First, the Office has failed to make out a prima facie case of obviousness because Sano has no need for Shih. Sano does not teach or suggest in any way that it would be desirable to allow the user to incorporate the user preference songs into the game. Sano teaches:

> A game communication system enhancing and improving clarity of players perception of a game. The game communication system includes gaming machine units connected to each other through communication modules which are adapted to perform a communication procedure within the game communication system. Each of the *gaming machine units* includes communication units adapted to execute the communication procedure to ensure bi-directional communications among the gaming machine units, a performance unit performing a sound track for a corresponding gaming machine unit, and a synchronization data setting unit setting

a synchronization data which is used to control operation timing of the performance unit. (Sano Abstract).

Accordingly, Sano is concerned with communication among gaming machine units, such as arcade video game units that one might play at a video arcade. Sano does not ever mention the ability or desire to allow a user to customize the game, let alone customize a game with the user's choice of music. Accordingly, the motivation given by the Office as to why one would modify Sano with Shih, is improper. For at least this reason, this claim is allowable.

In addition, while Goodman does mention the use of a user interface, Goodman is directed to a *portable music playback device.* A portable music playback device is not in any way related to a game console. Claim 14 recites a *game console* comprising a memory and a processor coupled to the memory, *the processor being configured to present a first user interface ... the processor further configured to present a second user interface.* Accordingly, claim 14 recites that the processor of a game console presents a first and a second user interface. Goodman on the other hand teaches an interface that is presented on a portable music device.

Furthermore, Goodman teaches that "the present invention provides an *efficient user interface for a small portable music player.* The invention is suitable for use with a *limited display area* and small number of controls to allow a user to efficiently and intuitively navigate among, and select, songs to be played." (Goodman, column 2, lines 6-10). Accordingly, Goodman's user interface is designed to meet certain design

specifications that are needed for a portable music device. An interface designed for use by a small portable music player would not be ideal for a game console interface which needs a display area that is large enough for a user to play a game. For this additional reason, the Office has failed to make out a *prima facie* case of obviousness. Thus, it appears that incorporating Goodman's interface into the references as argued by the Office would result in an interface that is inappropriately sized so as to adversely impact the functionality of either or both of the other references.

In addition, the Office's attempted combination appears to be squarely based on hindsight reconstruction insofar as the differences between the references and their operating environment are not reasonably reconcilable.

For all of the reasons mentioned above, the Office has failed to make out a *prima facie* case of obviousness. As such, this claim is allowable.

Claims 15 and 17-20 depend from claim 14 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 14, are neither shown nor suggested by the reference of record either singly or in combination with one another.

Claim 46 has been amended, and as amended recites a method comprising (added language appears in bold italics):

- identifying a plurality of stored audio tracks accessible by a game console;

- displaying *using the game console* at least a portion of the plurality of stored audio tracks to a user;
- receiving *with the game console* information regarding audio tracks selected by the user; and
- creating *with the game console* a soundtrack containing the audio tracks selected by the user.

In making out the rejection of this claim, the Office argues that Goodman anticipates claim 46. Claim 1 has been amended to recite displaying *using the game console* at least a portion of the plurality of stored audio tracks to a user; receiving *with the game console* information regarding audio tracks selected by the user; and creating *with the game console* a soundtrack containing the audio tracks selected by the user. In light of these amendments, Goodman does not anticipate claim 46.

Specifically, Goodman teaches methods for use by a portable music playback device. Even though Goodman teaches that the portable music playback device can transfer files to a game console, Goodman fails to teach or in any way suggest displaying *using a game console* at least a portion of the plurality of stored audio tracks to a user; receiving *with the game console* information regarding audio tracks selected by the user; and creating *with the game console* a soundtrack containing the audio tracks selected by the user.

For at least this reason, this claim is allowable.

Claims 47-51 depend from claim 46 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in

claim 46, are neither shown nor suggested by the reference of record either singly or in combination with one another.

Conclusion

All of the claims are in condition for allowance. Accordingly, Applicant requests a Notice of Allowability be issued forthwith. If the Office's next anticipated action is to be anything other than issuance of a Notice of Allowability, Applicant respectfully requests a telephone call for the purpose of scheduling an interview.

Respectfully submitted,

Dated: 8/31/06   By: _____
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